



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,598	07/12/2001	Toshiya Kanesaka	S004-4327	2220

7590 03/09/2004

ADAMS & WILKS  
ATTORNEYS AND COUNSELORS AT LAW  
31st Floor  
50 Broadway  
New York, NY 10004

EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/903,598

Applicant(s)

KANESAKA ET AL.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-29 are pending in this office action.

***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 12, 2001 have been objected. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "215" (page 20, lines: 2, 20, 24; page 22, line 18) and "216" (Figure 4) have both been used to designate acceleration sensor. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "215" has been used to designate both acceleration sensor and motor (page 20, lines: 2, 18, 20, and 24; page 22, line 18). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "113" (page 22, line 3) and "119" (Figure 6) have both been used to designate small-scale wireless section. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 2645

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "113" has been used to designate both small-scale wireless section (page 22, line 3) and LCD (Figure 3). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

7. The title of the invention has the term 'mobile communication device' repeated twice. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Method and system for providing service information through a mobile communication device, a portable terminal, a mobile communication management server, and a computer-readable recording medium".

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 5-10, and 28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,587,835 by Treyz et al, hereinafter Treyz.

Regarding claim 1, Treyz discloses a method of providing service information through a mobile communication device (see Abstract), comprising the steps of: accumulating service information to be transmitted to mobile communication devices (column 9, line 56 – column 10,

Art Unit: 2645

line 19); transmitting service information to an arbitrary mobile communication device (Figure 1, 12) during intervals between time periods for a main communication process, e.g. creating a shopping list performed by the arbitrary mobile communication device; and outputting the service information on the mobile communication device side (column 10, lines 14-15; column 10, line 56 – column 11, line 5; column 11, line 62-64; column 16, line 56 – column 17, line 9).

Regarding claim 2, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, comprising the step of transferring the service information from the mobile communication device receiving the service information to a portable terminal capable of direct communication with the mobile communication device, wherein the portable terminal outputs the service information (column 12, lines 11-19).

Regarding claim 3, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, comprising the step of requesting a user to confirm the user's intention to output the service information or not (column 3, lines 1-9; column 17, lines 5-7; column 26, lines 33-39; column 28, lines 5-17).

Regarding claim 5, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, comprising the step of transmitting the service information to the mobile communication terminal and inherently making the mobile communication terminal output the service information in a predetermined cycle during the main communication process (column 10, line 56 – column 11, line 5).

Regarding claim 6, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, the step of computing an amount claimed to be paid for communication such that the charge for communication to be paid by the user using

Art Unit: 2645

the service information during the main communication process is inherently reduced to zero while the service information provider is inherently charged the amount corresponding to the charge for communication (column 57, line 20 – column 58, line 36).

Regarding claim 7, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, the step of computing an amount claimed to be paid for communication such that the charge for communication to be paid by the user using the service information during the main communication process is discounted, while the service information provider is inherently charged the amount corresponding to the reduction in the charge for communication to be paid by the user (column 57, line 20 – column 58, line 36).

Regarding claim 8, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, comprising the step of adding a point for offering a privilege to the user according to the service information used by the user during the main communication process (column 11, line 57 – column 12, line 10; column 14, line 47 – column 15, line 2).

Regarding claim 9, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, comprising the step of transmitting the service information as letter or image information to the mobile communication device and making the mobile communication device display the information if the main communication process is a process of telephone communication using speech (column 16, lines: 1-15, lines 32-36; column 55, line 61 – column 56, line 7).

Regarding claim 10, a method of providing service information according to claim 1 mentioned above, wherein Treyz further discloses, comprising the step of transmitting the

Art Unit: 2645

service information as speech information to the mobile communication device and making the mobile communication device announce the information if the main communication process is a process of communication using letters or an image (column 16, lines: 16-22, 31-32; column 16, line 56 – column 17, line 10).

Regarding claim 28, wherein Treyz further discloses a computer-readable recording medium comprising a program stored thereon, the program enabling a computer to execute a method of providing service information through a mobile communication device according to claim 1 mentioned above (Figure 1; column 10, lines 9-19).

Regarding claims 11-13, 15-20, and 29, please see the rejections of the method in claims 1-3, 5-10, and 28 mentioned above, to reject the system in claims 11-13, 15-20, and 29.

Regarding claims 21 and 22, please see the rejections of the method in claims 1 and 2 mentioned above, to reject the mobile communication device in claim 21 and the portable terminal in claim 22.

Regarding claim 23-24, please see the rejections of the method in claims 3-4 mentioned above, to reject the portable terminal in claims 23-24.

Regarding claims 25-27, please see the rejections of the method in claims 1 and 28 mentioned above, to reject the mobile communication management server in claims 25-27.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,587,835 by Treyz as applied to claims 2 and 12, respectively, mentioned above, and further in view of U.S. Patent No. 6,640,115 by Fujimoto et al, hereinafter Fujimoto.

Regarding claim 4, a method of providing service information according to claim 2 mentioned above, wherein Treyz further discloses comprising the steps of: requesting a user to confirm the user's intention to output the service information or not; and outputting the service information by determining that the user has performed a predetermined confirmation operation (column 3, lines 1-9; column 17, lines 5-7; column 26, lines 33-39; column 28, lines 5-17).

Treyz does not disclose outputting the service information by determining that the user has performed a predetermined confirmation operation when an acceleration sensor provided in the portable terminal detects a predetermined acceleration.

Fujimoto discloses controlling an incoming call response operation on the basis of the movement speed of a portable terminal or radio telephone apparatus (see Abstract). A control circuit can determine that the radio telephone apparatus is moving at high speed or low speed (column 7, line 54 – column 8, line 10). A response operation is performed in accordance with the movement speed of said apparatus (column 9, lines 30-45).



Art Unit: 2645

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Treyz to include a portable terminal that has a control circuit as taught by Fujimoto in order to determine when to output service information on said terminal. One of ordinary skill in the art would have been lead to make such a modification since a user can determine when to have service information outputted on said terminal by confirming the acceleration of said terminal by a control circuit. The control circuit determines when said terminal is moving at high or low speed.

Regarding claim 14, please see the rejection of the method in claim 4 mentioned above, to reject the system in claim 14.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2002/0055351 by Elsey et al disclose a user using a mobile communication device can output service information on the mobile communication device and transmit information to a portable terminal

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Art Unit: 2645

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH  
lh

March 4, 2004

FAN TSANG  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2600

